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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,723	02/08/2002	Hartmut Ruf	A35001-PCT-USA-A-071986.0	3999

7590

04/02/2003

BAKER BOTTS L.L.P.
44TH FLOOR
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-0228

EXAMINER

EINSMANN, MARGARET V

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 04/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,723

Applicant(s)

RUF, HARTMUT

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 12, applicant claims the step of partially replacing the titanium contained in titanium dioxide with one or more heavy metals and partially replacing the magnesium contained in spinelle with one or more heavy metals. There is no description of the above steps in the specification. Applicant does not start with titanium dioxide or spinelle and then partially replace the titanium or magnesium. On the contrary, applicant uses well known inorganic pigments as disclosed in the specification at pages 6, wherein they are listed by their color index designations. In fact, applicant states on page 6 that the pigments are produced, "for example, by BASF...."

In claim 20, patentee claims using titanium dioxide as a colorant for cellulosic moulded bodies. There is no basis in the specification for using titanium dioxide except in the discussion of the prior art.

In claim 21, there is no basis for using titanium dioxide or spinelle in said process.

Claims 1-10, 12-15, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process and product wherein the cellulose moulded body is produced by precipitation from a solvent comprising N-methylmorpholine-N-oxide and spun, does not reasonably provide enablement for the full scope of the products and processes as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The product of claim 1 includes any form of moulded cellulose, for example, rayon fibers. The phrase, "wherein the colorant reduces the rise temperature of a cellulose solution in a tertiary amine oxide by at most 10°C." defines the colorant; it does not define the claimed product and process.

Claims 1-10, 12-15, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that the above claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification on page 4, lines 9-12. In that paragraph, applicant has stated " It is the object of the present invention to provide dyed cellulose moulded bodies, in particular of the color range of yellow, orange, red and brown, which may be produced by spin dyeing with heavy-metal-containing colorants in accord with the amine-oxide process," and this statement indicates that the invention is different from what is defined in the claim(s) because the

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claims do not define the particular cellulose being claimed, which is spun cellulose which has been produced by the amine oxide process, as stated in the above citation. Regarding claims 12, 20 and 21, the process wherein the pigments are used is not defined as a process of spinning cellulose which has been precipitated from an amine oxide solvent.

Claims 1-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "...by at most 10°C." and "at most 5°C." are vague and indefinite since they include the condition where there is no change in temperature.

Specification

The disclosure is objected to because of the following informalities: On page 6, list of inorganic pigments used in the invention, applicant refers to Pigment Yellow 24/77310 three times as an example of a pigment used in the process and product as claimed. However Pigment Yellow 24 is not Color Index number 77310, nor is it an inorganic pigment containing chromium and antimony as described. It is an organic pigment. Color Index 77310 is Pigment Brown 24, which is a pigment based on titanium dioxide, and which contains chromium and antimony as described. The Registry records for the above two pigments are appended to this action.

Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret Einsmann

Margaret Einsmann
Primary Examiner
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April 1, 2003